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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,581	08/25/2000	Hugh H. Birch	2610	5783

26389 7590 01/05/2007  
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE, WA 98101-2347

EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/648,581

Applicant(s)

BIRCH ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2-24-06.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Reopening of Prosecution after Decision by the Board of Patent Appeals under 37 C.F.R. § 1.198**

Prosecution in this application has been reopened under 37 CFR § 1.198, upon the authority of Technology Center 3600 Director, Wynn Coggins, for consideration of matters not already adjudicated before the Board of Patent Appeals.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-11 are rejected under 35 U.S.C. 101 because the claims fail to produce a tangible result.**

**Regarding claims 1-11**, in order for claimed subject matter to be considered patent eligible under 35 U.S.C. 101 it must contain a tangible result. The focus of this determination is on the result of the claim as a whole, not the individual steps or structure used to produce the result. Further to be tangible the process claim must set forth a practical application thereby producing a real-world result. It is the position of the Examiner that the result of the method of matching an offer for a product with a quote does not produce a tangible (real-world) result. There is no step that generates an actual result. Therefore, claims 1-11 are found to be directed towards subject matter, which is not patent eligible under 35 U.S.C. 101.

### Remarks

Claim 1 would be allowable if amended to overcome the rejection under 35 USC 101 set forth in this Office Action.

### Allowable Subject Matter

Claim 12 is allowable over the prior art of record.

Claim 24 is allowable over the prior art of record.

### Reasons for Indication of Allowable Subject Matter

The following is an examiner's statement of reasons for allowance:

#### Claim 12

Claim 12 recites a computer-readable medium having computer-executable instructions which, when executed on a computer, comprise: *inter alia*: ranking each preferred provider in a plurality of preferred providers according to a preferred criteria; and selecting a highest ranked preferred provider from the plurality of preferred providers.

The most closely prior art of record is U.S. Patent No. 5,331,546 to Webber. Webber discloses a travel planner system which automatically construct itineraries with available seats for a traveler's trip request (abstract). The system responds by finding the least costly but still valid itineraries in terms of a preset policy, individualized fro the particular traveler, regarding acceptable or desirable price tradeoffs between costs on the one hand and time and convenience on the other hand (col. 2, lines 5-10). The system has the ability to find not only the lowest fare on a given flight buy also the

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unprecedented ability to automatically find the flight or itinerary with the lowest fare, the ability to automatically take into account in this process the details of a preset, comprehensive corporate travel policy as well as details of persona travel preferences, the ability to show flight, fare, and seat availability (col. 2, line 62-col. 3, line 2). Webber discloses a flight search procedure which finds all the itineraries which could be used to satisfy the trip request being processed and to rank these candidate itineraries in terms of "non-preference" factors and to rank them in terms of personal preference factors (col. 7, lines 53-64). However, as stated by the Board of Appeals, Webber neither anticipates or fairly and reasonably teaches a computer-readable medium having computer-executable instructions which, when executed on a computer, comprise: *inter alia*: ranking each preferred provider in a plurality of preferred providers according to a preferred criteria; and selecting a highest ranked preferred provider from the plurality of preferred providers. The Board of Appeals has concluded, "Webber does not teach, and would not have suggested, providers (i.e., airlines) which meet the various preferred and non-preferred provider limitation".

#### Claim 24

Claim 24 recites a computer system for matching offers with quotes, comprising: *inter alia*: a travel server component configured to obtain at least one quote associated with each provider in a plurality of providers to provide the product at a cost, the plurality of providers comprising at least two groups: a preferred providers group and a non-preferred providers group, each preferred provider having a distinct preference ranking.

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and would not have suggested, providers (i.e., airlines) which meet the various preferred and non-preferred provider limitation”.

DeLorme (U.S. Patent No. 5,948,040) neither anticipates or fairly and reasonably teaches a computer system for matching offers with quotes, comprising: *inter alia*: a travel server component configured to obtain at least one quote associated with each provider in a plurality of providers to provide the product at a cost, the plurality of providers comprising at least two groups: a preferred providers group and a non-preferred providers group, each preferred provider having a distinct preference ranking. DeLorme disclosure teaches away a travel server component configured to obtain at least one quote associated with each provider in a plurality of providers to provide the product at a cost, the plurality of providers comprising at least two groups: a preferred providers group and a non-preferred providers group, each preferred provider having a distinct preference ranking. DeLorme teaches a computerized travel reservation information systems that permits a user to custom-define and examine a travel route and/or plans based upon answers to his questions (col. 6, lines 57-59). A user can construct a highly selective travel route that incorporates waypoints selected by the user and establish a computer link with computerized ticket and reservation systems (col. 6, line 65 – col. 7, line 1).

The Examiner notes that the “web server component” recited in claim 24 refer back to a computing device in the specification in page 19.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newly cited reference World Patent Publication WO 99/23595 to Walker discloses a collectible purchaser offer management system for receiving and processing individuals conditional purchaser offers from buyers (page 4, lines 23-24). The reference neither anticipates or fairly and reasonable teaches a computer system for matching offers with quotes, comprising: *inter alia*: a travel server component configured to obtain at least one quote associated with each provider in a plurality of providers to provide the product at a cost, the plurality of providers comprising at least two groups: a preferred providers group and a non-preferred providers group, each preferred provider having a distinct preference ranking.

Newly cited article ""Airlines Take to the Internet" discloses booking of air travel through the Internet which simplifies the tedious task of researching fares and schedules and saves time. The article neither anticipates or fairly and reasonable teaches a computer system for matching offers with quotes, comprising: *inter alia*: a travel server component configured to obtain at least one quote associated with each provider in a plurality of providers to provide the product at a cost, the plurality of providers comprising at least two groups: a preferred providers group and a non-preferred providers group, each preferred provider having a distinct preference ranking.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.



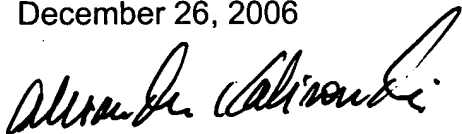
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

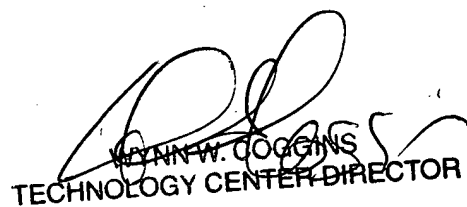
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot

December 26, 2006



**ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER**



**WYNNE W. COGGINS  
TECHNOLOGY CENTER DIRECTOR**